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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,208	03/25/2004	William L. Stewart II	TA-00658	6565
7590	06/03/2005		EXAMINER	
BRACEWELL & PATTERSON, L.L.P. P.O. BOX 61389 HOUSTON, TX 77208-1389			CONSILVIO, MARK J	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EK

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/809,208	STEWART, WILLIAM L.
Examiner	Art Unit	
Mark Consilvio	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-15, 17-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 13-22 and 24-31 is/are allowed.
- 6) Claim(s) 1-5, 7-10 and 12 is/are rejected.
- 7) Claim(s) 6 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 3/16/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the combination of Akin and von Stavenhagen would no longer work as intended, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation can be found in the knowledge generally available to one of ordinary skill in the art. Further, it is noted that the state of art concerning the application of light absorbing coatings can be evidenced in the teachings of Karki (US Patent No. 4,150,191) (col. 1, lines 17-41) and DePaoli (US Patent No. 5,373,644) (col. 2, lines 41-47).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akin (US Patent No. 3,672,782) in view of von Stavenhagen (US Patent No. 3,192,632).

With respect to claim 1, Akin discloses an optical device comprising a tube (12) having an axis (65), a proximal end (closest to the viewer), a distal end (further from the viewer), and an inner surface (see Fig. 1). Also Akin discloses an optical instrument (13) mounted inside the tube (12) and an optical flat (160) mounted inside the tube (12) between the optical instrument (13) and the distal end of the tube (see Fig. 1). Additionally, Akin discloses the optical flat (160) having a light-absorbing element (161) mounted thereto for reducing light emitted from the tube (see Fig. 14 and col. 7, lines 27-44). Further, the examiner notes that Akin refers to the light-absorbing element as, “a reflection-reducing coating,” preferably made of magnesium fluoride, a well-known light-absorbing material.

Akin is silent to or does not expressly disclose a light-absorbing treatment on the inner surface of the tube. However, coating the inner surface of optical tubes is well known in the art. Evidence of the use of light-absorbing treatments can be found in von Stavenhagen who discloses a light-absorbing treatment on at least a portion of the inner surface of a tube (see col. 4, lines 5-9). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Akin and von Stavenhagen and apply a light-

absorbing coating to the invention of Akin. One of ordinary skill in the art would have been motivated to do this to reduce reflections of light for better contrast or for avoiding detection.

With respect to claim 3, Akin discloses the optical flat (160) is mounted at an inclined angle relative to the tube (12) (see Fig. 1).

With respect to claims 4, Akin discloses the optical flat is elliptical and clearly shows that all light that reaches the optical instrument from the distal end of the tube passes through the optical flat (see Figs. 1 and 14 and col. 7, lines 30-50).

With respect to claim 5, Akin discloses the light-absorbing element is oval and opaque (see Fig. 14 and col. 7, lines 30-44) and, being coated on one side, is slightly off center with respect to the optical flat.

With respect to claim 7, though Akin does not expressly disclose that any light that enters the tube from the distal end that is reflected by the optical flat is absorbed by the light-absorbing treatment on the inner surface of the tube, the combined teachings of Akin and von Stavenhagen provide all the necessary structure capable of performing all the limitations detailed in claim 7. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Therefore, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to claim 8, though Akin does disclose the optical flat is transparent, Akin does not expressly disclose the optical flat has parallel surfaces or has a smoothness that varies no more than approximately one-fourth of a wavelength of the light passing therethrough.

However, it is well known that a smoother surface provides greater reflectivity. Likewise, it is known and commonly desired for optical flats to have the parallel surfaces. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Akin and von Stavenhagen to provide smooth parallel surfaces for the optical flat. One of ordinary skill in the art would have been motivated to do this to provide surfaces that with high reflectivity to send reflected light directly to the light absorbing coating while the allowing transmitted light to remain undistorted.

With respect to claim 9, though Akin does not expressly disclose that any light entering the optical instrument from the proximal end of the tube and light that is reflected from surfaces within the optical instrument emanate from virtual focal points within the optical instrument or that said any light is absorbed by the light-absorbing element. However, the combined teachings of Akin and von Stavenhagen provide all the necessary structure capable of performing all the limitations detailed in claim 9. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Therefore, if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to claim 12, though Akin does show the optical instrument is mounted adjacent to the proximal end of the tube, Akin does not expressly disclose the optical instrument magnifies a distant object for observation. However, magnification of such optical devices is conventional and well known in the art as evidenced by Akin (see col. 1, lines 54-58). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art

to combine the teachings of Akin and von Stavenhagen and add a magnification system to the combined invention of von Stavenhagen and Akin. One of ordinary skill in the art would have been motivated to do this more easily target a distant object.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akin (US Patent No. 3,672,782) in view of von Stavenhagen (US Patent No. 3,192,632) and in further view of Karki (US Patent No. 4,150,191).

As stated *supra*, the combine inventions of Akin and von Stavenhagen teach or suggest all the limitations of claim 1. With respect to claim 2, though neither Akin nor von Stavenhagen expressly disclose the light-absorbing treatment and the light-absorbing element absorb visible, UV, IR light, and other forms of electromagnetic radiation, Karki teaches that treatments for absorbing various forms of electromagnetic radiation are known. Evidence of the existence and use of such materials inside optical devices can be found in Karki (see col. 1, lines 17-41). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Karki, Akin, and von Stavenhagen and apply a light-absorbing coating disclosed in Karki to the combined invention of Akin and von Stavenhagen. One of ordinary skill in the art would have been motivated to do this to prevent the user from being observed by various optical detection systems.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akin (US Patent No. 3,672,782) in view of von Stavenhagen (US Patent No. 3,192,632) and in further view of Morgan (US Patent No. 6,488,381).

As stated *supra*, the combine inventions of Akin and von Stavenhagen teach all the limitations of claim 1. With respect to claim 10, Akin and von Stavenhagen do not expressly disclose an axial distance from the distal end of the tube to a nearest portion of the optical flat is greater than a diameter of the tube. However, Morgan discloses an invention to increase the distance to the distal end of the tube. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Morgan, Akin, and von Stavenhagen and apply extender of Morgan to the combined invention of Akin and von Stavenhagen. One of ordinary skill in the art would have been motivated to do for better collimation of incident light and further removal of reflected light producing a clearer field of vision (see Fig. 4 and col. 2, lines 22-33).

*Allowable Subject Matter*

Claims 13-15, 17-22, and 24-31 are allowed.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Though the prior art discloses an optical instrument including a tube with a light-absorbing treatment on at least a portion of the inner surface of the tube, and a planar inclined optical flat having a light absorbing coating, the prior art of record fails to teach or suggest the aforementioned combination further comprising the tube is free of light-transmissive instruments from the optical flat to the distal end of the tube. The prior art of record also fails to additionally

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teach or suggest the light-absorbing coating is on a proximal surface at a central portion of the optical flat wherein the proximal surface of the optical flat has an annular uncoated portion surrounding the coated light-absorbing coating at the central portion.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

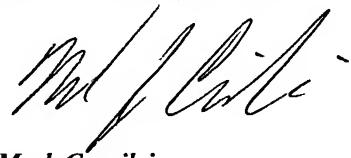
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

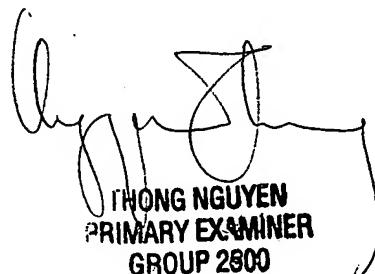
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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